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Attorney Docket RSW9-2000-0002-US1

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

In re application of Ronald P. Doyle

October 24, 2005

Serial Nbr: 09/537,068

Filed: March 28, 2000

For: Using Biometrics on Pervasive Devices for Mobile Identification

Art Unit: 2134

Examiner: Norman M. Wright

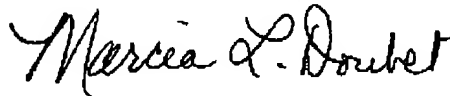
PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant hereby requests review of the Final Rejection in the above-identified Application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. Review is requested for the reasons stated on the attached sheets.

Respectfully submitted,



Marcia L. Doubet,
Attorney for Applicant
Registration Number 40,999

Customer Number for Correspondence: 43168
Phone: 407-343-7586
Fax: 407-343-7587

GROUND OF REJECTION PRESENTED FOR REVIEW

The first ground of rejection presented for review is a rejection of Claims 1 - 4, 7, 10 - 13, and 16 under 35 U.S.C. §102(e) as being anticipated by U. S. Patent 6,510,236 to Crane et al. (hereinafter, "Crane").

The second ground of rejection presented for review is a rejection of Claims 5 - 6, 8 - 9, 14 - 15, and 17 - 27 under 35 U.S.C. §103(a) as being unpatentable over Crane in view of U. S. Patent 6,016,476 to Maes et al. (hereinafter, "Maes").

ARGUMENT

With regard to the **First Ground of Rejection**, Appellant respectfully submits that a *prima facie* case of anticipation under 35 U.S.C. §102 has not been made out as to his Claims 1 - 4, 7, 10 - 13, and 16. Section 706.02 of the MPEP, "Rejection on Prior Art", states in Section IV, "Distinction Between 35 U.S.C. 102 and 103", the requirements for establishing a *prima facie* case of anticipation under this statute, noting that "... for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly" (emphasis added). This requirement is also stated in MPEP §2131, "Anticipation -- Application of 35 U.S.C. 102(a), (b), and (c)", which states (in its final paragraph) "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference", quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), emphasis added. This final paragraph of MPEP §2131 also states "The elements must be arranged as required by the

claim ...”, quoting *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990), emphasis added.

Appellant respectfully submits that the Office Action fails to identify where Crane teaches “each and every element” of his independent Claims 1 and 10 (or independent Claim 19, which contains analogous limitations) and fails to demonstrate that Crane teaches “elements ... arranged as required by [Appellant’s] claim”, and thus the Office Action analysis fails to make out a *prima facie* case of anticipation, in violation of the above-quoted MPEP §706.02 and §2131, as will now be demonstrated.

The text of record for Applicant’s independent Claims 1, 10, and 19 (as presented after Applicant’s Supplemental Amendment/Response submitted on December 6, 2004, referred to hereinafter as “Applicant’s supplemental response”) specifies limitations of “a mobile pervasive device possessed by a first party” (Claim 1, lines 5 - 6, emphasis added) and “capturing, using a biometric input reader which is attached to or incorporated within [this] mobile device possessed by [the] first party, biometric data of a second party” (Claim 1, lines 4 - 6, emphasis added). In Applicant’s *unentered* response dated July 25, 2005 (hereinafter, “Applicant’s second response”), the independent claims were amended to specify limitations of “a mobile device possessed by a user” (Claim 1, line 5, emphasis added) and “capturing, using a biometric input reader which is attached to or incorporated within [this] mobile device possessed by [the] user, biometric data of another being encountered by said possessor” (Claim 1, lines 4 - 6, emphasis added).

In other words, it is clear that Applicant’s independent claims specify two distinct parties:

the “first party” and the “second party” (or “the user” and “another being encountered by said possessor”, in Applicant’s second response). Crane does not teach a scenario that involves two distinct parties (nor does Maes). See also Applicant’s response dated June 21, 2004, hereinafter “Applicant’s first response”, page 9, lines 1 - 11 and Applicant’s second response, page 12, paragraph 1, where this claim limitation is discussed in more detail. Furthermore, the discussion in the Office Action ignores this distinction between the parties specified by Applicant. See, for example, the Office Action mailed on March 25, 2004, page 2, paragraph 2, line 6, where “third party/user” is treated as a single term. See also the Office Action mailed on June 1, 2005, page 2, paragraph 2, lines 5 - 6, referring to “a first or second party/user” (emphasis added). Crane’s references to a (single) device user are further discussed in Applicant’s first response (see page 8, Section I., paragraphs 2 - 3) and in Applicant’s second response (see page 12, paragraph 2).

Furthermore, Applicant respectfully submits (with regard to the claim language specified in his unentered second response) that neither Crane nor Maes has any teaching of a user, who possesses a device, encountering some other being.

In the Interview Summary provided with the Advisory Action mailed on September 14, 2005, the Examiner states that “a person/entity” (referring to Applicant’s “second party”) “becomes” a user upon using the biometric device. Applicant respectfully submits that this argument ignores claim limitations, including (i) the “user” (or “first party”) is one who possesses the mobile device (Claim 1, lines 5 - 6): assuming the biometric input reader is (for example) a fingerprint scanner, placing one’s finger on this reader does not make one become the

“possessor” of the mobile pervasive device; and (ii) with regard to the unentered claim language, the “another being” whose biometric data is being captured is “encountered by” the device possessor (Claim 1, line 6, emphasis added), whereas Crane has no teaching of anyone “encountering” anyone/anything else.

Applicant therefore respectfully submits that the Office Action fails to make out a *prima facie* case of anticipation as to his independent Claims 1 and 10 (as well as Claim 19); the dependent claims which depend therefrom are therefore considered allowable as well.

With regard to the **Second Ground of Rejection**, Appellant respectfully submits that a *prima facie* case of obviousness under 35 U.S.C. §103 has not been made out as to his Claims 5 - 6, 8 - 9, 14 - 15, and 17 - 27. Section 2143.03 of the MPEP, “All Claim Limitations Must Be Taught or Suggested”, makes reference to *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970), which stated “*All words* in a claim must be considered in judging the patentability of that claim against the prior art.” (emphasis added).

With regard to Applicant’s Claim 6, paragraph 5 of the Office Actions discuss “filtering” data as claimed therein (Claim 6, line 3), but again fail to consider the “second party” limitation of Applicant’s claims (Claim 6, line 4) – or, as specified in Applicant’s unentered second response, the “encountered being”. Applicant respectfully submits that filtering of data pertaining to a device user (as discussed in the Office Actions) is not equivalent to filtering of data pertaining to a “second party” who is being authenticated with a mobile pervasive device

possessed by some other party (i.e., "possessed by a first party", as specified in Applicant's independent Claim 1).

With regard to Applicant's Claim 8 (claiming "on-demand creation of a secure meeting site"; Claim 8, line 2), the cited text in col. 2, lines 50 - 58 of Maes merely refers to "access control cards for accessing ... a building". However, there is no suggestion of a *two-party* approach (i.e., using a mobile pervasive device possessed by a first party to authenticate "each of a plurality of meeting attendees") as claimed by Applicant; rather, Applicant submits that this single reference to "a building" in Maes is discussing use of a device positioned at a stationary meeting location, disadvantages of which have been discussed by Applicant on page 16, lines 1 - 16 of his specification.

With regard to Applicant's Claim 9 (claiming "exchange [of] a trusted message"; Claim 9, line 2), Applicant respectfully submits that the cited text in col. 2, lines 23 - 67; col. 3, lines 15 - 35; and col. 3, lines 40 - 67 of Maes fails to discuss a trusted message or a "second party [that] is a potential recipient" (Claim 9, line 4, emphasis added) of this trusted message.

Accordingly, all limitations/words of Applicant's dependent Claims 6, 8 - 9, 15, 17 - 18, 24, and 26 - 27 are not taught by the cited references. Accordingly, a *prima facie* case of obviousness has not been made out, and these claims are therefore deemed patentable over the references. Applicant's dependent Claims 5, 14, and 23 are deemed patentable by virtue of (at least) the allowability of the independent claims from which they depend.